

REMARKS

Claims 36-50 are pending in this application.

Claims 36, 37, 39, 41, 42, 44, 46, 47, and 49 are independent.

Claims 36-40 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The rejection is respectfully traversed.

The Examiner argues that claims 36-40 "have no connection to the technological arts. None of the steps indicate any connection to a computer or technology." (Paper No. 21, page 5, lines 8-9) The Examiner's position is not understood, as 35 U.S.C. §101 does not require that a claimed invention have "connection to a computer or technology."

As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). Section 101 of title 35 of the United States Code provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." As defined at 35 U.S.C. §100(b), "The term 'process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." Independent claims 36, 37, and 39 are each method claims. Thus each of these claims clearly falls into a statutory class (processes).

Further, an invention that falls into a statutory class must also satisfy the useful requirement of 35 U.S.C. §101. The Federal Circuit's State Street Bank decision holds that the test for whether a claim encompasses statutory subject matter under 35 U.S.C. §101 is whether the essential characteristics of the subject matter of the claim have practical utility, i.e., whether the claimed invention is useful. State Street Bank & Trust

Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998).

Each of independent claims 36, 37, and 39 have practical utility, i.e., paying a bill on behalf of a consumer, maintaining a master merchant file database, and processing consumer supplied payment records to add information to a master merchant file database.

Notwithstanding the fact that 35 U.S.C. §101 does not require that claims be directed to computers, the Examiner's argument that "none of the steps [of claims 36-40] indicate any connection to a computer or technology" is simply not understood. Independent claims 36 recites steps including determining if certain information is included in a database, adding that information to the database if not, and processing information to generate an instruction. Independent claim 37 recites steps for maintaining a database, including searching and adding information to the database. Independent claim 39 recites steps for processing certain information, including determining if certain information is included in a database, and adding that information to the database if not.

It would be understood by anyone of ordinary skill in the art that each of these claims is directed to methods performed, at least in part, utilizing a computer. Each of claims 36-40 expressly recites a database. According to the Microsoft Computer Dictionary, fifth edition (2002), a database is "a file composed of records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions." Furthermore, claims 36, 38, and 39 expressly recite "processing." Also according to the Microsoft Computer Dictionary, processing is "the manipulation of data within a computer system. Processing is the vital step between receiving data (input) and producing results (output) – the task for which computers are designed." Thus, it is clear that these claims are directed methods performed, at least in part, by a computer.

Accordingly, in view of the above, it is respectfully requested that the Examiner

reconsider and withdraw the 35 U.S.C. §101 rejection of claims 36-40.

Claims 36-50 stand rejected under 35 U.S.C. §103(a) as obvious over Lawlor et al. (U.S. Patent No. 5,220,51), in view of White et al. ("4-in-1 Accounting: The basics from Real-World" PC Magazine, v4, n20, p167-168, October 1, 1985). The rejection is respectfully traversed.

It is first perhaps worthwhile to note that the claims of the present application were previously rejected under 35 U.S.C. §103(a) as obvious over Lawlor, in view of Huber (U.S. Patent No. 4,791,561) (see Paper No. 6, 7/29/2002). The Examiner subsequently withdraw the rejection based upon the Lawlor/Huber combination and finally rejected the claims based upon Landry (U.S. Patent No. 5,956,700), arguing that claim amendments necessitated new grounds of rejection (see Paper No. 11). Applicants' representative traversed the finality of the rejection (see Request for Reconsideration dated April 10, 2003), arguing that the claim amendments only deleted unnecessary limitations and/or clarified claim language. Additionally, it was pointed out that the amendments were made in accordance with the understandings reached during an Examiner interview on September 24, 2002. The Examiner has now, in response to an Appeal, withdrawn the rejection under Landry and once again rejected the claims under Lawlor, this time in view of White. The Examiner's reading of Lawlor is essentially unchanged from the earlier rejection. As such, the prior traversal arguments regarding Lawlor are expressly incorporated herein.

The Examiner once again argues that Lawlor discloses all claimed features other than adding a merchant to a master merchant file database if the merchant is not included in the master merchant file database at the time of a search. The Examiner proposes to modify Lawlor based on the teachings of White, which relate to accounting software.

The Examiner asserts that Lawlor discloses a master merchant file database,

relying upon column 12, lines 21-26, column 14, lines 7-9, column 33, lines 24-34 and 51-60, column 43, lines 200-22. In particular, the Examiner relies upon Lawlor's disclosure of payee-specific lists and display of user-specific payees by category in arguing that Lawlor teaches a master merchant file database applicable to all users. It is again respectfully submitted that Lawlor lacks any disclosure of a master database of merchants or a database of merchants containing merchants received from or identified by multiple customers.

Rather, as explicitly disclosed in column 42, line 60, through column 43, line 25, and shown in Figures 14A-14C, the user must provide, prior to requesting any payments, merchant information relating to merchants to whom he/she wishes to pay electronically. This user-specific payee information is stored and accessed to display a list of payees to that user. Alternatively, the user-specific payee information may be displayed by payee category. Thus, Lawlor explicitly teaches only a user-specific merchant file and lacks any disclosure whatsoever of a master merchant file, i.e. a file which includes merchants identified by multiple users or consumers.

Accordingly, Lawlor fails to disclose the master merchant file database required by each of the independent claims. Hence, Lawlor necessarily fails to disclose the searching of such a file to determine if a merchant identified by a consumer (either during a registration type process, in conjunction with a request for payment, or otherwise) is included in such a master merchant file database. In fact, Lawlor explicitly teaches the creation of only user-specific merchant files.

Further, Lawlor does not teach searching even a user-specific payee list. Rather, as should be understood from the above, Lawlor merely discloses displaying user-specific payee lists, perhaps categorized.

The Examiner acknowledges that Lawlor does not teach or suggest adding a

merchant to a master merchant file database if the merchant is determined to not be included in that database. The Examiner looks to White for such. White is directed to the field of accounting software, not bill payment. Thus, White is not in the same field of art as Lawlor, nor in the same field of art as the present invention. The accounting software disclosed by White has the capability to print checks for a user based upon user-entered information associated with a disbursement, i.e, payee name and amount. Also, if the user issues a check by hand (not using the software to print the check), the user enters the disbursement information into the software (for accounting purposes). (See page 4, lines 14-15)

One feature of the software is a stored list of payees unique to that user, disclosed in the third full paragraph of page 4. With this feature, the payee enters payee information into the software and that information is stored for future use. In White, whenever the user enters a payee's name via a disbursement interface, the software determines if that payee name is stored. If the payee name is not stored in the software, the user can, at that point, go to a special add-payee interface and enter payee information for storage by the software. Thereafter, the user returns to the disbursement interface. Thus, White does not teach software adding a payee based upon received information. Rather, the user must manually add the payee.

Furthermore, like Lawlor, White does not teach, nor does it suggest, a master database of merchants or a database of merchants containing merchants received from or identified by multiple customers. This is especially true, since White is directed to accounting software utilized by a single user. Accordingly, White does not cure the defects in the applied Lawlor reference.

It is respectfully submitted that there is nothing within either of the applied art references which suggests the combination proposed by the Examiner. That is, even if

Lawlor were to disclose a master merchant file database (which it does not), there is nothing in either Lawlor or White to suggest searching a merchant file for a merchant identified by a user or consumer and adding the identified merchant to the merchant file if that merchant is not already included in the merchant file. Thus, there is no motivation for the proposed combination.

In summary, even if the applied art combination were proper (which it is respectfully submitted is not the case), the applied combination lacks the determining and adding required by independent claim 36, the searching and adding required by independent claim 37, the determining and adding required by independent claim 39, the storage device and processor required by independent claims 41, 42 and 44, and programming which causes a computer to make the determination and add the merchant as required by independent claims 46 and 49, and programming which causes a computer to search and add an identified merchant as required by independent claim 47.

Additionally, features recited in the dependent claims further and independently distinguish over the applied prior art.

For example, the applied art lacks any disclosure whatsoever of adding a merchant to a merchant file in conjunction with a request for payment as required by claim 38. Lawlor specifically discloses that the merchant information must be provided by the user prior to any request for payment of a bill. And White specifically discloses that the user must enter payee information.

As noted above, the applied art also lacks a master merchant file database which includes merchants identified by multiple consumers or users as required by claim 40. Furthermore, features recited in dependent claims 43, 45, 48 and 50 also independently distinguish over the applied prior art for reasons which are believed to be clear from the

above discussion.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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